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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,034	08/16/2000	Toshiyuki Yoneda	BEAR-006	3757
24353	7590	08/16/2004		
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025				
			EXAMINER WAX, ROBERT A	
			ART UNIT 1653	PAPER NUMBER

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,034

Applicant(s)

YONEDA ET AL.

Examiner

Robert A. Wax

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 21 and 22 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (WO/99/60017) and US 6,673,900.

This rejection was explained in the previous Office action as the obviousness part of the rejections under 35 USC 102(b)/103.

3. Claims 23 and 24 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (both WO 99/60017 and US Patent 6,673,900) in view of Cerny et al.

This rejection was explained in the previous Office action.

Response to Amendment

4. The amendment canceling claims 1-20 has overcome all rejections of record except those reiterated above.

Response to Arguments

5. Applicant's arguments filed July 1, 2004 have been fully considered but they are not persuasive. The most pertinent argument made by applicant is that unexpected results have been shown in the specification. The argument is reproduced below.

Applicants point out that the four sequences which are recited within amended claim 21 show improved unexpected results with respects to other sequences which are part of the longer sequence taught by Rowe.

Within Example 1 beginning on page 13 of the specification applicants have recited six specific sequences. The data shown within the specification such as the data of Figure 4 clearly show that the four specific sequences which are claimed as part of the formulation of claim 21 demonstrate improved unexpected results relative to other sequences which are fragments of the larger sequence disclosed by Rowe.

Examiner respectfully disagrees with the conclusion that these data constitute evidence of unexpected results. Yes, the other two sequences tested are other portions of SEQ ID NO: 2 of Rowe but they do not contain the critical RGD portion. As pointed out on page 7 of the previous Office action, Rowe provides specific guidance to select peptides containing RGD when the desired effect is bone growth. The results provided in the instant specification show that peptides containing RGD exhibit better bone-growth abilities than peptides that do not contain RGD. This result is completely expected from the teachings of Rowe. The specifically claimed peptides would be expected to enhance bone growth at the same level as other peptides containing RGD. If applicants have evidence that SEQ ID NOs: 43, 44, 45 and 47 have superior bone growth generating characteristics superior to other RGD-containing peptides they are

invited to submit it in declaration form. Such evidence would constitute evidence of unobviousness and overcome the rejections under 35 USC 103. Until such evidence is provided no claim is allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (571) 272-0623. The examiner can normally be reached on Monday through Friday, between 9:00 AM and 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name.

Robert A. Wax
Primary Examiner
Art Unit 1653

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